



**RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2876
PATENT**

Customer No. 22,852
Attorney Docket No. 5793.3124-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Charles A. ROSENBLATT)	Group Art Unit: 2876
)	
Application No.: 10/796,188)	Examiner: Kim, Ahshik
)	
Filed: March 10, 2004)	Confirmation No.: 2746
)	
For: SYSTEMS AND METHODS FOR)	
AUTOMATICALLY)	
DISTRIBUTING GIFTS TO)	
RECIPIENTS ON BEHALF OF)	
CUSTOMERS)	

Commissioner for Patents
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Alexandria, VA 22313-1450

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Madame or Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Applicant requests a pre-appeal brief review of the Final Office Action dated January 24, 2006. This request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

The Applicant has met each of the requirements for a pre-appeal brief review of the rejections set forth in an Office Action. In particular, the application has been at least twice rejected, the Applicant has filed a Notice of Appeal with the Request, and the Applicant has not yet filed an Appeal Brief. Lastly, the Applicant submits a Pre-Appeal Brief Request for Review that is five (5) or fewer pages in length and sets forth legal or factual deficiencies in the rejections. (See Official Gazette Notice, July 12, 2005.) Therefore, the Applicant requests review of the Examiner's rejections in the Final Office Action for the reasons indicated below.

II. The Rejection of Claims 1-39 is Legally Deficient Because the Examiner Failed to Address All of the Applicant's Arguments

M.P.E.P. § 707.07(f) requires the Examiner to "take note of the applicant's argument and answer the substance of it" when the Applicant traverses any rejection. The Examiner has not met this burden by failing to address the substance of the Applicant's arguments presented in the Amendment filed on November 7, 2005. For example, the examiner did not address arguments set forth in the Amendment indicating that *Phillips* does not disclose "preparing a communication to the recipient to provide the financial card to the recipient at the predetermined delivery time." Also, the examiner did not address the requirement that a predetermined delivery time be received "from a consumer." Thus, the Examiner failed to answer the substance of the Applicant's arguments presented in the Amendment in connection with claims 1-39 and thereby failed to meet the requirements of M.P.E.P. § 707.07(f).

III. The Examiner's Assertion That *Phillips* "Virtually" Discloses The Claimed Invention is Legally Deficient

The Examiner suggests that *Phillips* does not disclose each feature of independent claims 1, 13, and 25. For instance, the Examiner makes the sweeping allegation that the paraphrasing of the prior art by the Applicant is "virtually what is recited in claim 1" (Final Office Action at 4).

However, it is improper to reject a claim under 35 U.S.C. § 102 based on the position that a cited reference "virtually" discloses all limitations of the claim. The Examiner may not distill an invention down to a "gist" or "thrust," and then reject the "gist" or "thrust" of the invention. M.P.E.P. § 2141.02. Instead, the Examiner must look at the claimed invention as a whole and must compare the recited elements against the prior art. The Examiner's assertion that *Phillips* "virtually" discloses the claimed invention is tantamount to distilling the invention down to a "gist" or "thrust," which, as explained, is legally improper.

To the extent that the Office Action relies on principles of inherency in alleging that *Phillips* "virtually" discloses the features of claims 1, 13, and 25, the rejection is still legally improper. Inherency requires evidence that "make[s] clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." M.P.E.P. § 2131.01(III).

Here, the portions of *Phillips* relied on by the Examiner do not disclose — inherently or otherwise — the features of claims 1, 13, and 25 relating to a “predetermined delivery time” received “from a consumer.” As explained below, nothing in *Phillips* discloses or suggests this element as recited in claims 1, 13, and 25.

Therefore, the rejections of independent claims 1, 13, and 25 under 35 U.S.C. § 102 are legally deficient and should be withdrawn.

IV. The Rejection of Claims 1-39 is Legally Deficient Because the Examiner Failed to Establish a *Prima Facie* Case of Anticipation Under 35 U.S.C. § 102

The Applicant respectfully traverses the rejection of claims 1-39 under 35 U.S.C. § 102 as being anticipated by *Phillips* because the Examiner failed to establish a *prima facie* case of anticipation.

In order to properly establish that *Phillips* anticipates the Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claims at issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 calls for:

A method, performed by a processor, for providing a financial card to at least one recipient for a consumer, the method comprising: receiving financial card distribution information from a consumer, wherein the financial card distribution information identifies at least one recipient for a financial card and a predetermined delivery time for providing the financial card to the recipient; storing the financial card distribution information in a database, such that the stored financial card distribution information is associated with the consumer; and preparing a communication to the recipient to provide the financial card to the recipient at the predetermined delivery time.

Contrary to the Examiner's assertions, all of the claimed elements are not found in *Phillips*. For Example, *Phillips* does not disclose a predetermined delivery time, as recited in claim 1. In the Final Office Action, the examiner states “. . . the card is delivered at a suitable time and place (Col. 4, lines 1-8).” However, in paraphrasing the prior art, the examiner has improperly changed the meaning and substance of the

citation and mischaracterized the cited invention. In proper context, Phillips states, "[t]he place of delivery may be arranged during the initial purchase of the card or other suitable time before delivery." The "suitable time" refers to acceptable moments for arranging the "place of delivery." No reference is made as to determining a time for delivery. Indeed, the only reference to delivery time by *Phillips* is in col. 4, lines 1-2 which states, "[w]hen the purchase card account is complete, the card is delivered." Again the delivery time is not received from a consumer and is not predetermined. Instead, the delivery of the card depends on the occurrence of another event. The time of that event is not controlled or predetermined. Thus, *Phillips* does not teach or suggest receiving a predetermined delivery time from a consumer as recited in claim 1.

Phillips also fails to disclose preparing a communication to the recipient at the predetermined delivery time. Instead, Phillips indicates "[w]hen the purchase card account is complete, the card is delivered." No preparation of "a communication to the recipient to provide the financial card to the recipient" is disclosed in *Phillips*. This element is neither taught nor suggested by the prior art.

Claims 13 and 25 include recitations similar to those of claim 1. As explained, *Phillips* does not support the rejection of claim 1. Accordingly, the cited art also fails to support the rejection of independent claims 13 and 25 for at least the same reasons set forth above in connection with claim.

Claims 2-12, 14-24 and 26-39 depend from independent claims 1, 13 and 25. As explained, *Phillips* does not support the rejection of claims 1, 13 and 25. Accordingly, the cited art also fails to support the rejection of dependent claims 2-12, 14-24 and 26-39 for at least the same reasons set forth above in connection with claims 1, 13 and 25.

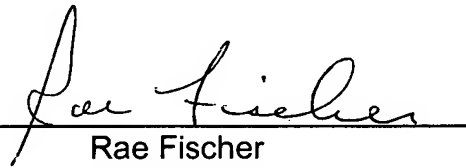
For at least these reasons, the Office Action has not established a *prima facie* case of anticipation and the rejection of claims 1-39 under 35 U.S.C. § 102 and should be withdrawn and the claims allowed.

V. Conclusion

For at least the reasons cited above, the Final Office Action includes deficiencies with regard to the rejection of claims 1-39 under 35 U.S.C. § 102 based on *Phillips*. As such, the Applicant respectfully requests that the rejection of the pending claims be withdrawn and the claims allowed.

Respectfully submitted,

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